Supreme Court, U.S.
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IN THE
SUPREME COURT OF THE UNITED STATES
OCTOBER TERM, 1995

MICRON SEPARATIONS, INC.,
Petitioner,

v.

PALL CORPORATION,
Respondent.

On Petition for a Writ of Certiorari
to the United States Court of Appeals
for the Federal Circuit

SUPPLEMENTAL BRIEF IN SUPPORT OF PETITION FOR A WRIT OF CERTIORARI

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SUPPLEMENTAL BRIEF OF PETITIONER IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

Petitioner Micron Separations, Inc. ("MSI") respectfully submits this Supplemental Brief in support of its petition for certiorari to provide this Court with new information not in existence at the time MSI filed its initial brief. MSI believes it is important for this Court to consider the fact that certiorari has now been granted in a case presenting nearly identical factual and legal issues, namely *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.* (No. 95-728).

CERTIORARI SHOULD BE GRANTED TO REVIEW THIS CASE AT THE SAME TIME AS THE *HILTON DAVIS* CASE (NO. 95-728)

On February 26, 1996, this Court granted certiorari in *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.* (No. 95-728), to review the same fundamental question of patent law as that posed in MSI's petition for certiorari. In *Hilton Davis*, this Court will consider how broadly a patent claim may be construed under the doctrine of equivalents when the accused device or process clearly does not fall within the literal scope of the patent claim at issue.

As MSI pointed out in its initial brief, the MSI case and *Hilton Davis* present the Court with substantially identical legal and factual issues. The Federal Circuit's decision in the MSI case relies on its decision in *Hilton Davis*, which is reported at 62 F.3d 1512 (Fed. Cir. 1995) (*en banc*). Pet. App. 11a. The MSI case and *Hilton Davis* involve strikingly similar facts. Each involves a patent on polymer membrane technology, and each involves claims directed to certain narrow ranges of properties. In both *Hilton Davis* and the MSI case, the court found no literal infringement, but found infringement under the doctrine of equivalents even though the accused processes and products were well below the claimed lower limit of the ranges of the respective patents. In *Hilton Davis*, the patentee narrowed its claims during the patent application process to require the use of a pH range of "from approximately 6.0 to 9.0." *Hilton Davis*, 62 F.3d at 1515-16. In the MSI case, the patentee (Pall) narrowed its claims to require use of a nylon having a specific chemical ratio within a range of "about 5:1 to about 7:1." Pet. App. 12a-13a. In *Hilton Davis*, the Federal Circuit held that a process with a pH of 5.0 infringed, even though the lower limit of the claim was

"approximately 6.0." *Hilton Davis*, 62 F.3d at 1524. In the MSI case, the Federal Circuit held that a ratio of 4:1 infringed, even though the lower limit of the claim was "about 5:1." Pet. App. 16a.

In its initial brief, MSI noted that if this Court granted certiorari in *Hilton Davis*, it also should consider the MSI case, to see that the issues raised in *Hilton Davis* have widespread applicability in patent cases. Now that certiorari has been granted in *Hilton Davis*, this Court either should grant certiorari here in view of the similarity of the cases, or at the very minimum, defer decision on MSI's case until after it decides *Hilton Davis*, and then determine the impact on the MSI case of the Court's *Hilton Davis* decision.[1]

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[1]Respondent Pall, in its Opposition Brief, attempts to ignore the legal similarities between the *Hilton Davis* and MSI cases, and tries to distinguish this case from *Hilton Davis* based on factual issues involved at the Patent and Trademark Office, and by claiming that MSI did not "contest" the doctrine of equivalents issue below. MSI's appeal to the Federal Circuit clearly raised the issue of whether a claim could be broadly construed beyond its literal scope. In any case, it is unnecessary for the Supreme Court to consider Pall's assertion of "differences" between *Hilton Davis* and this case, because it is for the Federal Circuit or district court on remand to address Pall's assertion, *after* this Court decides whether a claim can be expanded broadly beyond its literal meaning.

CONCLUSION

The Petition for a Writ of Certiorari should be granted.

Dated: March 14, 1996

Respectfully submitted,

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